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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,293	01/02/2002	Arnold B. Finestone	82017-1399	1249
28765	7590	08/04/2004	EXAMINER	
WINSTON & STRAWN PATENT DEPARTMENT 1400 L STREET, N.W. WASHINGTON, DC 20005-3502			AUGHENBAUGH, WALTER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,293

Applicant(s)

FINESTONE ET AL.

Examiner

Walter B Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 19, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claim 12 in the amendment filed April 19, 2004 (Amdt. C) have been received and considered by Examiner.
2. New claim 26 presented in Amdt. C has been received and considered by Examiner.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. 112 rejection of claim 12 made of record in paragraph 4 of Paper 13 has been withdrawn due to Applicant's amendments in claim 12 in Amdt. C.
4. The 35 U.S.C. 112 rejection of claim 12 that was repeated in paragraph 5 of Paper 13 has been withdrawn due to Applicant's amendments in claim 12 in Amdt. C.
5. The 35 U.S.C. 103 rejections of claims 12-25 that were repeated in paragraphs 6 and 7 have been withdrawn due to Examiner's reconsideration of the rejections in view of Applicant's arguments presented in Amdt. C.

NEW REJECTIONS

6. Claims 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finestone et al. in view of Redmond.

In regard to claims 12, 13 and 26, Finestone et al. disclose a paper-plastic laminate having a plastic film (item 12, Fig. 2) laminated to a paper sheet (item 14, Fig. 2) via an adhesive layer (item 13, Fig. 2) (col. 5, lines 9-28). Finestone et al. disclose that the plastic film (that corresponds to the first reinforcing film as claimed) is oriented or biaxially oriented to increase the tensile strength of the film (col. 5, lines 9-19). Finestone et al. disclose that the surfaces of the film are subject to corona treatment that increases the surface energy (measured in dynes) of

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the film, thereby rendering the film wettable to allow for better bonding of the adhesives applied thereto (col. 6, lines 1-18). Finestone et al. disclose that the adhesive used for the adhesive layer is a water-based adhesive that permits cold lamination at ambient temperature since water-based adhesive is fluid at ambient temperature and therefore does not require heat (col. 5, lines 28-39). Finestone et al. disclose that cold lamination at ambient temperature enables the oriented film to maintain its orientation and is therefore essential to produce a laminate of high tear and burst strength (col. 5, lines 33-39); therefore, Finestone et al. teach that the laminate has enhanced tear and burst strength compared to the tear and burst strength of dilatable containers made from plastic coated cellulosic papers that are not laminated. In regard to the recitations that the laminate is "capable of being converted..." and is "printable", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. *In re Hutchison*, 69 USPQ 138.

Finestone et al. fail to teach a second reinforcing (plastic) film that is treated and bonded to the paper sheet as the first reinforcing film is.

Redmond, however, discloses a package laminate including a sheet of relatively stiff, but flexible material such as paperboard (item 4, Fig. 4; col. 4, lines 46-49) covered at its opposite sides with plastic sealant films (items 6 and 8, Fig. 4; col. 3, lines 34-40) that protect the outer package surface and that keeps the package clean and attractive (col. 4, line 68-col. 5, line 3). Therefore, one of ordinary skill in the art would have recognized to have bonded a second reinforcing film (i.e. another reinforcing film of Firestone et al.) to the surface of the sheet paper of Finestone et al. that does not have a reinforcing film bonded to it in order to protect that surface of the sheet of paper of Finestone et al. and to keep the sheet of paper clean and attractive

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as taught by Redmond. Since the packages taught by Redmond are suited for packaging liquids (col. 2, lines 62-68), the laminate structure taught by Redmond (plastic/paper/plastic) is necessarily moisture resistant, and the laminate structure taught by the combination of Finestone et al. and Redmond is necessarily moisture resistant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have bonded a second reinforcing film (i.e. another reinforcing film of Firestone et al.) to the surface of the sheet paper of Finestone et al. that does not have a reinforcing film bonded to it in order to protect that surface of the sheet of paper of Finestone et al. and to keep the sheet of paper clean and attractive as taught by Redmond.

In regard to claims 14-16 and 21, Finestone et al. disclose that a polyacrylic copolymer is a suitable polymer for use as the water-based adhesive (col. 5, lines 26-27 and col. 7, line 47), that polyester, polypropylene and polyethylene are suitable materials for the plastic film (col. 5, lines 9-13 and col. 12, lines 29-30) and that Kraft paper is a suitable paper for the paper sheet (col. 10, lines 12-26).

In regard to claims 17-20 and 22-25, Finestone et al. disclose that a second paper layer (item 17, Fig. 6) is laminated to plastic film 12 via water-based adhesive 13 and that the outer surface of plastic film 12 is treated in order to render the surface wettable (col. 7, line 66-col. 8, line 6). The second paper layer Finestone et al. is the facing sheet as claimed by Applicants. Finestone et al. also disclose that coated paper is used as the outer finish liner of corrugated paper board for labeling the board with printed data or to apply decorative graphics thereto (col. 1, lines 21-28). Since Finestone et al. teach the interchangeable use of corrugated paper board and planar paper (col. 7, lines 39-41), one of ordinary skill in the art would have recognized to

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have adhesively laminated the facing layer (second paper layer 17) of Finestone et al. to one, or both, of the plastic films of the laminate taught by Finestone et al. and Redmond in order to provide an outer paper layer or outer paper layers to the laminate taught by Finestone et al. and Redmond for labeling the laminate with printed data or for applying decorative graphics thereto as taught by Finestone et al.

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments on pages 5-10 of Amdt. C regarding the 35 U.S.C. 103(a) rejection of claims 12-25 over Redmond in view of Finestone et al. are moot due to the withdrawal of this rejection in this Office Action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

07/30/04

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

8/3/04